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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/444,261	11/22/1999	DANIEL JACOFF		8417

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EXAMINER

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ART UNIT	PAPER NUMBER
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2859

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/444,261

Applicant(s)
Jakoff

Examiner
Gail Verbitsky

Art Unit
2859



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 24, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 8-11, 13, 20-25, and 35-45 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration
- 5) ☒ Claim(s) 43-45 is/are allowed.
- 6) ☒ Claim(s) 1, 8-11, 20-25, and 35-42, 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 2859

DETAILED ACTION

Restriction/ Election

1. Applicant's election with traverse of the invention of Group I, claims 1-25 and 35-45, is acknowledged. Accordingly, claims 26-34, drawn to non-elected invention, are withdrawn from further consideration.

Applicant states that the search for the vial would require to search for the mold and for the level. This argument is not persuasive because, although it is true for many vials, not all vials are necessarily made by making a mold, and used in levels, as well as some levels do not require vials. Furthermore, the methods of molding are known to be used for a vast variety of structures other than vials. Thus, the search for the vial would not require to search the level and mold areas. Therefore, the restriction requirement stated in Paper # 3 is hereby repeated and thus made **FINAL**.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 8-9, 13, 20-25 and 35-42 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

Art Unit: 2859

application was filed, had possession of the claimed invention. In this case, the "integral"/ "one piece", as stated in claims 1, 8-9, 13, 20-25 and "in a single step", as stated in claims 35-42 have not been described in the originally presented specification.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 9-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In this case, "opposed spaced from the apex and opposed spaced sides at an angle 90 degrees from the apex" in lines 3-4 makes the claim language is confusing because it is not clear what applicant means. Perhaps applicant should insert --, planes tangent to said opposed sides are-- after "spaced sides" in line 3 (similar to claim 1). Is this a proper interpretation of the invention? Furthermore, please note, that in the rejection on the merit, the examiner considers that the --planes tangent to said opposed sides are at 90 degrees angle from the apex".

Claims 10-11 are rejected by virtue of their dependency on claim 9.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 2859

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johansson (Sweden 148436) [hereinafter Johansson] in view of Wright (U.S. 5003699).

Johansson discloses in Figs. 1-3 a device comprising a straight cylindrical outer wall, a curved inner cavity A having a substantially uniform arc in a cross section throughout its length, the arc having an apex 5, the apex is closer to the cylindrical outer wall than to the opposed wall G of the inner cavity. Johansson also discloses a cup B, opposed ends C spaced from the apex. At least one end of the cavity terminates in a wall D. Planes tangent to opposed spaced sides E and F meet at 90 degrees at the apex (Fig. 3). The planes tangent to the sides of the cavity are parallel to each other and at 90 degree angles to the plane tangent to the apex (Fig. 3). (The numerals A-G have been added by the Examiner, see attachment # 1 to the Office Action).

Johansson does not disclose an orienting means (keys) being an integral with the straight cylindrical outer wall, as stated in claims 1, 8, that the keys are extending from an open end and having an edge and a wall, as stated in claim 9.

Wright discloses in Fig. 1 a device in the field of applicant's endeavor comprising orienting means having keys extending from an open end and being an integral with a straight cylindrical outer wall. The keys have an edge and a wall, wherein the edge is perpendicular to the wall (see attachment # 2 to the Office Action).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device disclosed by Johansson, so as to have keys, as taught by

Art Unit: 2859

Wright, integral with a straight cylindrical outer wall at the open end, in order to provide a device with a good support on the surface and be able to align the device with the horizontal axis.

8. Claims 35-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wright in view of Johansson and Ours (U.S. 5595518).

Wright discloses in Fig. 1 a device in the field of applicant's endeavor, the device comprising an inner cavity having a curved surface of an inner wall 30, a straight cylindrical outer wall 16. Wright discloses an orienting means, keys, extending as an integral with the outer wall from an open end and extending in opposite direction to each other. The keys have an edge and a wall. The apex of the curved surface is formed closer to the outer wall than to the ends of the inner cavity. Planes tangents to opposed spaced sides E and F meet at 90 degrees at the apex. Planes H-I tangent to the sides of the cavity are parallel to each other and at 90 degree angles to the plane tangent to the apex. One end of the cavity is formed by terminating (closed end) 26. The open end of the device is closed with a cap. (The numerals E-I have been added by the Examiner, see attachment # 2 to the Office Action). The device is being formed by an injection molding.

Wright does not explicitly state that both, curved inner and straight cylindrical outer, surfaces/ walls are formed simultaneously in a single step, as stated in claim 35. Wright does not teaches that the inner cavity has a uniform cross section along the length, as stated in claims 36, 38, with the remaining limitations of claims 36-42.

Art Unit: 2859

Johansson discloses a device whose curved inner surface has a shape whose cross section is a uniform.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device disclosed by Wright, so as to have the inner cavity with a uniform cross section along the length, as taught by Johansson, because the courts have held that change in shape or configuration, without criticality, is within the level of skill in the art as the particular shape claimed by applicant is nothing more than one of the numerous shapes that a person having ordinary skill in the art will find obvious to provide. *In re Dailey*, 149 USPQ 47 (CCPA 1976).

Ours teaches that by using an injection molding, all the surfaces of an article can be made simultaneously by injecting a material in a single step into a prepared mold.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of forming the device disclosed by wright, so as to use a one step injection molding for simultaneously making an inner and an outer surfaces of the device, as taught by Ours, so as to minimize the time and costs of the manufacturing process.

With respect to claims 35-42: the method steps will be met during the normal manufacturing process of the device stated above.

Allowable Subject Matter

9. A) Claims 43-45 are allowed.

Art Unit: 2859

B) Claims 13, 20-25 are rejected as stated in paragraph 3.

C) Claims 9-11 would be allowable if rewritten to overcome the rejection(s) under 35

U.S.C. 112, second paragraph, set forth in this Office action.

Response to Arguments

10. Applicant's arguments with respect to claim have been considered but are moot in view of the new ground(s) of rejection.

Applicant states that Johansson does not disclose an orienting means, a method of making a vial. Applicant states that the orienting means of Johnson is merely a holder and not an integral, that Johnson does not disclose a method of making a vial with a straight outer and curved inner cavity, that the applied prior art does not disclose a method of forming a straight outer wall and a curved inner wall simultaneously in one step.

A) These argument are moot in view of the new ground of rejection.

B) Please note, that the limitations stating that the keys being an "integral", as stated in the amended claims 1, 8-9, 20-25, and that the device is formed "in a single step", as stated in claims 35-42, added by the present amendment in the specification, substitute a new matter since they have not been presented in the originally filed specification and claims.

Conclusion

Art Unit: 2859

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited in the PTO-892 and not mentioned above disclose related devices and methods.

12. Any inquiry concerning this communication should be directed to the Examiner Verbitsky whose telephone number is (703) 306-5473.

Any inquiry of general nature should be directed to the Group receptionist whose telephone number is (703) 308-0956.

GKV

March 01, 2003

Gail Verbitsky



Patent Examiner, TC 2800